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12 INVITROGEN CORPORATION

13 UNITED STATES DISTRICT COURT
14 SOUTHERN DISTRICT OF CALIFORNIA

15 INVITROGEN CORPORATION, a
16 Delaware Corporation,

17 Plaintiff,

18 v.

19 PRESIDENT AND FELLOWS OF
20 HARVARD COLLEGE, a Massachusetts
21 Corporation,

22 Defendant.

23 Case No. 07 CV 0878 WOH RBB

24 COMPLAINT

25 DEMAND FOR JURY TRIAL

26 RECEIVED

27 MAY 30 2007

28 U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

29 COMPLAINT

30 Plaintiff Invitrogen Corporation ("Invitrogen") for its complaint against the defendant
31 President and Fellows of Harvard College ("Harvard"), states as follows:

32 THE NATURE OF THE ACTION

33 1. This is a civil action to remedy the decisions and judgment of the Board of Patent
34 Appeals and Interferences ("Board") of the United States Patent and Trademark Office
35 ("USPTO") adverse to party Chatterjee in Interference No. 105,292, titled "Deb K. Chatterjee,
36 Junior Party (Application 09/558,421) v. Stanley Tabor and Charles Richardson, Senior Party
37 (Patent 5,614,365)" as provided for by 35 U.S.C. § 146.

1 **THE PARTIES**

2 2. Invitrogen is a corporation organized and existing under the laws of the state of
3 Delaware, having its principal place of business at 1600 Faraday Avenue, Carlsbad, California
4 92008.

5 3. Upon information and belief, Harvard is a corporation organized and existing
6 under the laws of the State of Massachusetts, having its principal place of business at 1033
7 Massachusetts Avenue, 3rd Floor, Cambridge, Massachusetts 02138. Upon information and
8 belief, Harvard is authorized to engage in business in California, is registered and does business
9 in California by entering into repeated and successive transactions in this state, and has appointed
10 an agent for service of process, namely, Corporation Service Company, which does business in
11 California as CSC – Lawyers Incorporating Service, PO BOX 526036, Sacramento, California
12 95852. Upon information and belief, Harvard has filed tax returns in the state of California.
13 Upon information and belief, Harvard owns and leases real property in the state of California.
14 Upon information and belief, Harvard has employees in the state of California. Upon information
15 and belief, Harvard has had and does have agents operating on its behalf with respect to the
16 subject matter of this Complaint in the state of California and in this judicial district (e.g., Patent
17 5,614,365 was prosecuted on Harvard's behalf by attorneys at the law firm of Lyon & Lyon LLP,
18 at its offices located in Los Angeles and San Diego, California).

19 **JURISDICTION AND VENUE**

20 4. Jurisdiction is based on 28 U.S.C. §§ 1331 and 1338 and 35 U.S.C. § 146.

21 5. Venue is proper in this judicial district under 28 U.S.C. § 1391.

22 **CLAIM FOR RELIEF**

23 **(Civil Action under 35 U.S.C. § 146)**

24 6. Invitrogen realleges and incorporates by reference paragraphs 1-5 of this
25 Complaint.

26 7. On April 6, 2005, the USPTO declared an interference, designated as Interference
27 No. 105,292 ("the '292 interference"), under 35 U.S.C. § 135(a) between United States Patent
28

1 Application Serial No. 09/558,421 ("the Chatterjee '421 application") and United States Patent
2 No. 5,614,365 ("the Tabor '365 patent").

3 8. The Chatterjee '421 application and the Tabor '365 patent generally relate to
4 molecular cloning and expression of mutant DNA polymerases.

5 9. In declaring the '292 interference the USPTO determined that certain claims of the
6 Chatterjee '421 application and the Tabor '365 patent interfere because they claim common
7 subject matter. The '292 interference is based on a single "count" that defines the interfering
8 subject matter in the alternative: claim 1 of the Chatterjee '421 application or claim 1 of the Tabor
9 '365 patent. Only the first inventor of subject matter corresponding to the count is entitled to
10 patent claims directed to that subject matter.

11 10. The USPTO designated claims 1-6 and claims 15-20 of the Chatterjee '421
12 application as corresponding to the count.

13 11. Deb K. Chatterjee is the first inventor of the subject matter of claims 1-6 and
14 claims 15-20 of the Chatterjee '421 application, which is entitled to priority under 35 U.S.C. §
15 120 to the priority benefit of the filing date of Chatterjee's priority applications, namely, United
16 States Patent Application Serial No. 08/576,759, filed December 21, 1995 ("the Chatterjee '759
17 application"), United States Patent Application Serial No. 08/537,397, filed October 2, 1995 ("the
18 Chatterjee '397 application"), and United States Patent Application Serial No. 08/525,057, filed
19 September 8, 1995 ("the Chatterjee '057 application").

20 12. The entire right, title, and interest in and to the Chatterjee '421, the Chatterjee '759
21 application, the Chatterjee '397 application, and the Chatterjee '057 application have been
22 assigned to Invitrogen, which, for the purposes of this action, is the real party in interest for said
23 applications.

24 13. The USPTO designated claims 1-3, 5-11, 32, 40, 55, 56, 63, 69, and 70 of the
25 Tabor '365 patent as corresponding to the count.

26 14. Upon information and belief, Stanley Tabor and Charles Richardson claim to be
27 the inventors of the subject matter of claims 1-3, 5-11, 32, 40, 55, 56, 63, 69, and 70 of the Tabor
28 '365 patent, which purports to be entitled to the benefit under 35 U.S.C. § 120 of United States

1 Patent Application Serial No. 08/324,437, filed October 17, 1994 ("the Tabor '437 application"),
2 now abandoned.

3 15. Upon information and belief, Stanley Tabor and Charles Richardson have assigned
4 all rights in the Tabor '365 patent and the Tabor '437 application to Harvard, which, for the
5 purposes of this action, is the real party in interest for the Tabor '365 patent.

6 16. During the '292 interference and on March 15, 2007, the Board mailed and filed
7 paper no. 109, titled "Judgment – Merits – Bd. R. 127" (attached hereto as Exhibit A), which
8 reads in part: "ORDERED that judgment is entered against Chatterjee; FURTHER ORDERED
9 that Deb. K. Chatterjee is not entitled to a patent to claims 1-6 and 15-20 of Application
10 09/558,421, which correspond to Count 1 and which are all the claims of the application."

11 17. During the '292 interference and on March 15, 2007, the Board mailed and filed
12 paper no. 108, titled "Decision – Priority – Bd. R. 125(a)" (attached hereto as Exhibit B), which
13 reads in part: "ORDERED that Chatterjee Motion 2 for priority is denied."

14 18. The Board's decisions or judgment in the '292 interference were based upon
15 several erroneous determinations adverse to party Chatterjee, including, but not limited to, those
16 set forth in paragraphs 19-21 of this Complaint.

17 19. During the '292 interference and on March 15, 2007, the Board erroneously
18 determined that Chatterjee failed to show, by a preponderance of the evidence, that Chatterjee
19 actually reduced to practice an embodiment of the Count prior to Tabor's accorded benefit date.

20 20. During the '292 interference and on March 15, 2007, the Board erroneously
21 determined that Chatterjee failed to show, by a preponderance of the evidence, an actual
22 reduction to practice of an embodiment within the scope of the Count on September 12, 1991.

23 21. During the '292 interference and on March 15, 2007, the Board erroneously
24 determined that Chatterjee failed to show, by a preponderance of the evidence, an actual
25 reduction to practice of an embodiment within the scope of the Count on July 29, 1994.

26 22. Upon information and belief, no party to the '292 interference has appealed the
27 decision of the Board to the United States Court of Appeals for the Federal Circuit.
28

1 PRAYER

2 WHEREFORE, Invitrogen prays for a judgment:

3 1. Reversing all portions of the Board's decisions or judgment adverse to Chatterjee
4 including reversing the Board's decisions of March 15, 2007 against Chatterjee: that Deb. K.
5 Chatterjee is not entitled to a patent to claims 1-6 and 15-20 of the Chatterjee '421 application,
6 and that Chatterjee failed to show, by a preponderance of the evidence, an actual reduction to
7 practice of an embodiment within the scope of the Count prior to the earliest accorded benefit
8 date of the Tabor '365 patent.

9 2. Adjudging that Deb K. Chatterjee is the first inventor of the invention defined by
10 the count and that Invitrogen is entitled to a patent of the United States for said invention;

11 3. Determining that all claims of the Tabor '365 patent corresponding to the count are
12 unpatentable to Tabor;

13 4. Entering judgment for Invitrogen and against Harvard in the '292 interference;

14 5. Declaring this action an exceptional case;

15 6. Awarding Invitrogen its costs in this action, including its reasonable attorneys'
16 fees; and

17 7. Awarding Invitrogen such other and further relief as the Court may deem just and
18 proper.

19 JURY TRIAL DEMAND

20 Invitrogen hereby demands a trial by jury on all issues so triable.

21 DATED: May 15, 2007

PERKINS COIE LLP

22 By: 

23 Michael J. Wise, Bar No. 143501

24 M Wise@perkinscoie.com

25 Attorneys for Plaintiff
26 Invitrogen Corporation
27
28

Invitrogen Corporation
v.
President and Fellows of Harvard College

EXHIBIT A
TO COMPLAINT

Paper 109

Filed by Trial Division Motions Panel
Mail Stop Interference
P.O. Box 1450
Alexandria VA 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Filed:
March 15, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEB K. CHATTERJEE
Junior Party,
(Application 09/558,421),
v.
STANLEY TABOR
and CHARLES RICHARDSON,
Senior Party,
(Patent 5,614,365).

MAILED

MAR 15 2007

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 105,292

Before Delmendo, Lane, and Nagumo, Administrative Patent
Judges.

Nagumo, Administrative Patent Judge.

1 **Judgment -- Merits -- Bd.R. 127**

2 For the reasons set out in the Decision, Paper 108,

3 mailed on the same date as this JUDGMENT, it is:

4 ORDERED that adverse judgment is entered against
5 Chatterjee;

6 FURTHER ORDERED that Deb K. Chatterjee is not
7 entitled to a patent to claims 1-6 and 15-20 of Application

EXHIBIT A
Page 7

COMPLAINT

Interference 105,292
Chatterjee v. Tabor

1 09/558,421, which correspond to Count 1 and which are all
2 the claims of the application.

3 FURTHER ORDERED that a copy of this JUDGMENT
4 shall be entered into the records of Application 09/558,421
5 and U.S. Patent 5,614,365.

6 FURTHER ORDERED that in the event of a settlement,
7 the attentions of the parties are drawn to 35 U.S.C.
8 § 135(c) and Bd.R. 205.

9

/Romulo H. Delmendo/)

ROMULO H. DELMENDO)

Administrative Patent Judge)

)

)

/Sally Gardner Lane/) BOARD OF PATENT

SALLY GARDNER LANE) APPEALS AND

Administrative Patent Judge) INTERFERENCES

)

)

/Mark Nagumo/)

MARK NAGUMO)

Administrative Patent Judge)

Interference 105,292
Chatterjee v. Tabor

cc (via Overnight mail):

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Invitrogen Corporation
v.
President and Fellows of Harvard College

EXHIBIT B
TO COMPLAINT

Filed by Trial Division Motions Panel
Mail Stop Interference
P.O. Box 1450
Alexandria VA 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Filed:
March 15, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEB K. CHATTERJEE
Junior Party,
(Application 09/558,421),
v.
STANLEY TABOR
and CHARLES RICHARDSON,
Senior Party,
(Patent 5,614,365).

MAILED

MAR 15 2007

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 105,292

Before Delmendo, Lane, and Nagumo, Administrative Patent
Judges.

Nagumo, Administrative Patent Judge.

1 **Decision - Priority - Bd. R. 125(a)**

2 I. Introduction

3 The subject matter of this interference relates to the
4 discovery of a class of mutant DNA polymerase enzymes. The
5 critical mutation is the substitution in the DNA polymerase
6 of a single tyrosine residue for a specific phenylalanine
7 residue, which is equivalent to adding an -OH ("hydroxyl")

1 group to the phenyl group of the phenylalanine residue.
2 The tyrosine mutation resulted in the ability of the
3 mutated enzyme to incorporate dideoxynucleotides into the
4 DNA molecule about as efficiently as deoxynucleotides.
5 Once a dideoxynucleotide is incorporated into the DNA, the
6 polymerization can no longer continue and the chain is
7 terminated. For fascinating reasons that need not delay
8 our consideration of the issues before us, the principal
9 practical interest of the disputed enzymes is that they
10 enabled the transformation of DNA sequencing by the "chain
11 termination method" from an expensive laboratory technique
12 yielding results that could be difficult to evaluate into
13 an inexpensive, powerful, and widely used analytical tool.
14 (See, e.g., Second Declaration of I. Robert Lehman, Ph.D.,
15 TX 1028 at 2, ¶ 7, through 4, ¶ 9; "I am confident that the
16 rapid progress and success of the human genome project seen
17 in the mid to late '90s and early 2000's was to a
18 significant extent dependent on the DNA polymerase [of this
19 interference]." *Id.* at 4, ¶ 9, last sentence.)

20 The parties have filed motions for priority. Tabor
21 has also filed a motion for judgment, deferred from the
22 interlocutory phase of this interference (Paper 27 at 2),
23 that Junior Party Chatterjee's claims are anticipated by

1 disclosures by Tabor. Both parties have moved to exclude
2 certain evidence.

3 Oral argument was heard 5 March 2007 (transcript,
4 Paper 107). Kevin W. McCabe, Esq., argued for Chatterjee.
5 Richard J. Warburg, Esq., argued for Tabor.

6 For the reasons set out *post*, we hold that junior
7 party Chatterjee has failed to establish in its principal
8 brief a *prima facie* case that it was first to reduce to
9 practice an embodiment within the scope of the Count.
10 Accordingly, as Chatterjee did not argue diligence, we DENY
11 Chatterjee's motion for priority. As there is no way
12 Chatterjee can prevail in this interference, we DISMISS the
13 remaining motions of both parties as moot. Judgment is
14 entered separately in Paper 109, which is mailed on the
15 same date as this Decision.

16 II. Findings of Fact

17 The following findings of fact and those set out in
18 the Discussion are supported by a preponderance of the
19 evidence of record.

20 Junior Party Chatterjee

21 1. Deb K. Chatterjee (Dr. Chatterjee) is the named
22 inventor for Chatterjee.

1 2. Chatterjee is involved on the basis of application
2 09/558,421 (TX 1006)¹, which was filed 26 April 2000,
3 as a Continuation of
4 08/576,759 (TX 1005), filed 21 December 1995, now
5 abandoned, which was filed as a Continuation of
6 08/537,397 (TX 1004), filed 2 October 1995, now
7 abandoned, which was filed as a Continuation-in-Part of
8 08/525,057 (TX 1003), filed 8 September 1995, now
9 abandoned.

10 3. Chatterjee has been accorded the benefit for priority
11 of each of the above-listed applications. (Paper 1 at 4.)

12 4. The real-party-in-interest for Chatterjee is
13 identified as Invitrogen Corp. (Paper 7 at 2.)

14 5. Invitrogen Corp. is said to be the "surviving entity"
15 of a merger between Invitrogen Corp. and Life Technologies,
16 Inc. ("LTI"), the company for which Dr. Chatterjee and
17 numerous fact witnesses worked at the relevant times.
18 (SX 2043 at 1 n.1.)

19 Senior Party Tabor

20 6. Stanley Tabor and Charles Richardson are the named
21 inventors for Tabor.

¹ Chatterjee exhibits are referred to as "CX 2xxx", while Tabor exhibits are referred to as "TX 1xxx".

1 7. Tabor is involved on the basis of U.S. Patent
2 5,614,365 (TX 1039), issued 25 March 1997, which is based
3 on
4 08/337,615, filed 10 November 1994, as a Continuation-
5 in-Part of
6 08/324,437 (TX 1027), filed 17 October 1994, now
7 abandoned.

8 8. Tabor has been accorded the benefit for priority of
9 each of the above-listed applications. (Paper 1 at 4.)

10 9. The real-party-in-interest for Tabor is identified as
11 the President and Fellows of Harvard College. The United
12 States Department of Energy is identified as having a
13 nonexclusive license. (Paper 11 at 1.)

14 The Count

15 10. The sole count in this interference is:

16 Claim 1 of Chatterjee (09/558,421)

17 or

18 Claim 1 of Tabor (5,614,365).

19 (Paper 1 at 5.)

20 11. Claim 1 of Chatterjee reads (line breaks and
21 indentation added):

22 A DNA molecule comprising

1 a coding sequence for a mutant protein,
2 wherein said mutant protein is a mutant DNA
3 polymerase selected from the group consisting of:
4 E. coli DNA polymerase I,
5 Klenow fragment of E. coli DNA polymerase I,
6 Streptococcus pneumoniae polymerase,
7 Thermus aquaticus polymerase,
8 Thermus flavus polymerase,
9 Thermus thermophilus polymerase,
10 Deinococcus radiodurans polymerase,
11 Bacillus caldotenax polymerase,
12 E. coli bacteriophage T5 polymerase,
13 mycobacteriophage L5 polymerase,
14 Thermatoga maritima polymerase, and
15 E. coli bacteriophage SP01 polymerase,
16 wherein said mutant DNA polymerase comprises
17 a substitution of Tyr for Phe at a position
18 in said polymerase corresponding to Phe570
19 of wild-type T5 polymerase.

20 (Paper 5 at 3.)

21 12. A merits panel of the Board held that a DNA covered by
22 Chatterjee claim 1 must encode a protein that polymerizes
23 DNA. (Paper 57 at 15.)

24 13. Claim 1 of Tabor 5,614,365 reads:

25 Modified gene encoding a modified Pol I-type DNA
26 polymerase
27 wherein said modified gene is modified to encode
28 a tyrosine residue at an amino acid position
29 corresponding to T7 DNA polymerase residue 526 or
30 at an amino acid position corresponding to
31 E. coli DNA polymerase residue 762 in its dNMP
32 binding site
33 to increase ability of said modified DNA
34 polymerase to incorporate a dideoxynucleotide
35 relative to a corresponding deoxynucleotide
36 compared to the ability of a corresponding

1 naturally-occurring unmodified DNA polymerase by
2 at least 20-fold.

3 (Paper 12 at 1.)

4 14. The claims of the parties are:

5 Chatterjee: 1-6 and 15-20

6 Tabor: 1-108

7 15. The claims of the parties that correspond to the Count
8 and that are involved in this interference are:

9 Chatterjee: 1-6 and 15-20

10 Tabor: 1-3, 5-11, 32, 40, 55, 56, 63, 69,
11 and 70.

12 16. The claims of the parties that do NOT correspond to
13 the Count and that are NOT involved in this interference
14 are:

15 Chatterjee: none

16 Tabor: 4, 12-31, 33-39, 41-54, 57-62,
17 64-68, and 71-108.

18 Chatterjee Motions

19 17. Chatterjee Motion 1 (Paper 65) seeks judgment for
20 priority. Tabor opposed (Paper 80) and Chatterjee replied
21 (Paper 87).

22 18. Chatterjee Motion 2 (Paper 89) seeks to exclude
23 certain exhibits. Tabor opposed (Paper 97) and Chatterjee
24 replied (Paper 98).

1 Tabor Motions

2 19. Tabor Motion 2 (Paper 75) seeks judgment that all of
3 Chatterjee's involved claims are anticipated under 35 U.S.C.
4 §§ 102(a) or (e). Chatterjee opposed (Paper 77) and Tabor
5 replied (Paper 81).
6 20. Tabor Motion 3 (Paper 76) seeks judgment for priority,
7 including judgment that Chatterjee derived the invention
8 from Tabor. Chatterjee opposed (Paper 78) and Tabor
9 replied (Paper 82).
10 21. Tabor Motion 4 (Paper 92) seeks to exclude certain
11 exhibits. Chatterjee opposed (Paper 96) and Tabor replied
12 (Paper 99).

13 Priority Statements

14 22. Chatterjee asserts in its priority statement an
15 earliest corroborated actual reduction to practice date of
16 10 September 1991. (Paper 37 at 2.)
17 23. Chatterjee asserts in its priority statement an
18 earliest corroborated conception date of 14 June 1991.
19 (Paper 37 at 2.)
20 24. Tabor asserts in its priority statement an earliest
21 corroborated actual reduction to practice date of 11 August
22 1994. (Paper 28 at 1.)

1 25. Tabor asserts in its priority statement an earliest
2 corroborated conception date of 2 October 1993. (Paper 28
3 at 1.)

4 Chatterjee Motion 1 (Priority)

5 26. Chatterjee moves for judgment that it was the first to
6 conceive and the first to reduce to practice based on two
7 different embodiments within the scope of the Count.
8 (Paper 65 at 10 and 14.)

9 27. Chatterjee argues that it actually reduced to practice
10 embodiments of the invention no later than 12 September
11 1991, and no later than 29 July 1994. (Paper 65 at 13-14.)

12 28. Chatterjee argues further that it did not abandon,
13 suppress, or conceal its invention. (Paper 65 at 19.)

14 29. Chatterjee makes no attempt in its principal brief to
15 prove diligence from conception through an actual or
16 constructive reduction to practice.

17 First embodiment: T5 F570Y mutant

18 30. Chatterjee argues that an actual reduction to practice
19 of a T5 DNA polymerase F570Y mutant, in which, *inter alia*,
20 the phenylalanine ("F") at amino acid residue position 570,

1 was replaced by tyrosine ("Y"), was done on 12 September

2 1991, by Dr. John Hughes ("Hughes") and Dr. Chatterjee.

3 31. According to Chatterjee, on that date, Hughes and

4 Dr. Chatterjee showed that the prepared molecule had

5 polymerase activity. (Paper 65 at 13.)

6 32. Chatterjee cites Facts 99 and 100 in support of its

7 actual reduction to practice. (Paper 65 at 13.)

8 33. Fact 99 reads:

9 99. On or about September 12, 1991, John Hughes
10 performed experiments to purify and analyze and
11 analyze [sic] E. coli DNAP (JH19). This activity
12 was recorded on page[s] 89-92 of notebook 3048.
13 Exhibit CX2007, pages 89-92.

14 (Paper 65 at 51.)

15 34. Fact 100 reads:

16 100. On or about September 12, 1991, Deb
17 Chatterjee performed [sic] a series of
18 experiments to test the enzymatic activity of the
19 mutated pSport T5 polymerase, indicating a 4 fold
20 higher specific activity in induced clone 4 over
21 the uninduced clone, and 2-3 fold higher specific
22 activity of induced clone 7 over the uninduced
23 clone. I also performed a restriction
24 endonuclease assay of pSport T5 and identified
25 that the clones were mutated and in the correct
26 orientation. These experiments are recorded on
27 page 45 of notebook 3128. Exhibit CX 2009,
28 page 45.

29 (Paper 65 at 51.)

1 35. Exhibit CX 2007 is presented as LTI notebook #3048,
2 issued to John Hughes on 11 February 1991. (CX 2007
3 at pdf3².)

4 36. Exhibit CX 2009 is presented as LTI notebook #3128,
5 issued to Deb Chatterjee on 16 May 1991, entitled "T5 DNA
6 Polymerase." (CX 2009 at pdf3.)

7 37. Chatterjee, in its principal brief, does not direct
8 our attention to any inventor testimony, nor to any
9 corroborating testimony by non-inventors, in support of the
10 alleged actual reduction to practice on 12 September 1991.

11 38. Reviewing the notebook pages and declarations cited by
12 Chatterjee in Statements of Material Fact 99 and 100, we
13 find, albeit without the benefit of any guiding testimony,
14 that:

15 a. In notebook #3048, at pages 89-92, Hughes
16 recorded Experiment JH-19, the purpose of which was,
17 in his words, to "[t]est Deb Chatterjees 4 amino acid
18 point mutation of T5 DNA polymerase for activity."³
19 (CX 2007 at 89.)

² Citations to Party Chatterjee's notebook pages are to the number printed on the page. Covers, title pages, etc., are not numbered, and are cited by the page number in the pdf file provided by Chatterjee on the CD-ROM disk.

³ All of Hughes' entries are in capital letters, not reproduced here for ease of reading.

1 b. At page 90 of notebook #3048, Hughes wrote under
2 a table of assays of cell lysates, "Sample #4 shows a
3 2-fold enhancement in activity over the uninduced
4 control. This may not be significant however."
5 (CX 2007 at 90.)

6 c. There does not appear to be a comparable
7 statement regarding the activity of Sample #7 on
8 notebook #3048 pages 89-92.

9 d. Dr. Chatterjee appears to have recorded the
10 results of Hughes' experiments in notebook #3128 at
11 page 45:

12 Gave all 4 Samples to J. Hughes
13 * * *
14 The results indicate that Sp. activity of #4
15 induced clone was 4 fold greater than that
16 of uninduced.
17 Sp. activity of #7 induced was @ 2-3 fold
18 higher."
19 (CX 2009 at 45.)

20 e. Chatterjee has not directed our attention to any
21 testimony explaining the relation of Chatterjee's
22 characterizations of the specific activity of
23 samples #4 and #7 to the data recorded in Hughes'
24 notebook #3048.

1 f. In particular, we have not been directed to any
2 explanation of the 4-fold greater specific activity of
3 sample #4.

4 g. We also find in notebook #3128 at page 45 a
5 report of a test with "AccI", and the comments, "AccI
6 confirms that the clones are correct," and "I need to
7 wait for a thermostable DNA polymerase for the same or
8 similar mutation." (*Id.*)

9 h. Dr. Chatterjee testifies that he "performed a
10 restriction endonuclease assay of pSport T5 and
11 identified that the clones were mutated and in the
12 correct orientation. These experiments are recorded
13 on page 45 of notebook 3128." (CX 2043
14 at pdf15⁴, ¶ 47.)

15 i. We do not find a further explanation of the
16 experiments reported at notebook #3128 at 45 (CX 2009)
17 in Chatterjee's declaration (CX 2043).

18 j. In particular, Chatterjee has not directed our
19 attention to testimony explaining the "AccI" test or
20 the significance of Dr. Chatterjee's statement that he

⁴ The pages are not numbered in the hard copy.

1 needed "to wait for a thermostable DNA polymerase for
2 the same or similar mutation."

3 Second embodiment (Taq F667Y)

4 39. Chatterjee argues that it has demonstrated a second
5 actual reduction to practice no later than 29 July 1994,
6 when Dr. Chatterjee received an oligonucleotide,
7 synthesized for him by the LTI synthesis facility, having
8 the stated purpose of making an F667Y mutation in Taq DNA
9 polymerase. (Paper 65 at 14.)

10 40. According to Chatterjee, after Dr. Chatterjee received
11 the oligonucleotide, he performed an oligonucleotide-
12 directed mutagenesis on the Taq polymerase gene and
13 obtained a clone incorporating the mutant sequence.
14 (Paper 65 at 14.)

15 41. Chatterjee argues that the identity of the clone was
16 confirmed by demonstration of an additional AseI
17 restriction site derived from the oligonucleotide.
18 (Paper 65 at 14.)

19 42. Chatterjee argues further that thermostable polymerase
20 activity was demonstrated by incorporating an
21 "NgoAIV - XbaI restriction fragment" into an "inducible
22 expression vector," which was transformed into bacteria.

1 Expression was induced, and an assay of the resulting
2 culture showed thermostable polymerase activity. (Paper 65
3 at 15.)

4 43. Chatterjee cites Facts 837 and 838 in support of this
5 asserted actual reduction to practice. (Paper 65 at 14.)

6 44. Fact 837 cites CX 2062 (a from requesting synthesis),
7 CX 2043 at ¶¶ 90 and 91 (Chatterjee declaration), and
8 CX 2021 at 166 (Chatterjee laboratory notebook #3573).
9 (Paper 65 at 260-61, ¶ 837.)

10 45. Exhibit CX 2062 is a copy of a sheet headed "REQUEST
11 FOR SYNTHESIS OF OLIGONUCLEOTIDES," dated "7/26/94," from
12 "Deb K. Chatterjee," apparently requesting two
13 oligonucleotides, the sequences of which are specified.

14 46. Oligonucleotide #2 is labeled "#2680, (33-mer)" and
15 briefly described as "F667Y mutation of Taq." (CX 2062.)

16 47. Dr. Chatterjee, in ¶ 90 of his declaration (CX 2043 at
17 pdf24-25) describes the order he placed on 26 July 1994,
18 for oligonucleotides, focusing on Sequence 2680.

19 48. In particular, Dr. Chatterjee points out the
20 subsequence |GTA|ATT|AAT|, describing the triplet GTA as
21 the complement of the tyrosine codon TAC, and describing

1 the sequence ATTAAT as the "AseI restriction site."
2 (CX 2043 at 25, ¶ 90.)
3 49. Dr. Chatterjee concludes:
4 Ms. Licha[a] completed the synthesis of the
5 oligonucleotide and provided it to me on or about
6 July 29, 1994, as shown on the bottom signature
7 line of this order form (Exhibit CX 2062), and I
8 recorded this information in notebook 3573,
9 page 166. A copy thereof is attached as exhibit
10 CX 2021, page 166.
11 (CX 2043 at 25, ¶ 90.)
12 50. Exhibit CX 2021, cited by Dr. Chatterjee, appears to
13 be a copy of part of LTI Notebook #3573.
14 51. LTI Notebook #3573 appears to have been issued to Mary
15 Longo on 27 January 1993. (CX 2021 at pdf3.)
16 52. Exhibit CX 2021 contains 24 pages; the first data page
17 is a copy of page 153; the last page is a copy of page 175.
18 53. Chatterjee Notebook #3573 at 166 is signed by
19 ("Recorded by") Chatterjee and dated "8/12/94"; it also
20 bears an illegible countersignature ("Witnessed &
21 Understood by me," that is dated "8/17/94". (CX 2021
22 at 166 [pdf 15].)
23 54. LTI Notebook #3573 at 166 refers to "Oligos ordered
24 Q582A & F667Y on 7/26/94." (CX 2021 at 166, l. 1.)

1 55. LTI Notebook #3573 at 166: refers to Sequence 2680 as
2 a 33-mer, further labeled "F667Y"; gives the DNA base
3 sequence for the oligomer; and reports that it was
4 "dissolved in 990 µl TE: 1000 ng/µl (1 µg/µl)". (CX 2021
5 at 166, ll. 4-6.)

6 56. LTI Notebook #3573 at 166 appears to contain no other
7 indications of experiments conducted with Sequence 2680.

8 57. In particular, on page 166 there appears to be no
9 record of any experiment on 29 July 1994 showing that a
10 protein within the scope of the Count (i.e., containing
11 Sequence 2680, the critical tyrosine-for-phenylalanine
12 mutation, or the "NgoAIV - XbaI restriction fragment")
13 having DNA polymerase activity was obtained.

14 58. Moreover, on page 166, there appear to be no
15 indications that a restriction map was obtained on
16 29 July 1994.

17 59. Fact 838 is in almost the same words as
18 Dr. Chatterjee's testimony:

19 Therefore, on or about July 26, 1994, to July 29,
20 1994, I had a definite and permanent idea of a
21 mutant Taq DNA polymerase with polymerase
22 activity and non-discrimination properties
23 comprising a phenylalanine to tyrosine
24 substitution at position 667, including its full-
25 length sequence.

1 (CX 2043 at 25, ¶ 91.)

2 60. Chatterjee, in its principal brief, does not direct
3 our attention to any testimony explaining how the events
4 alleged to have occurred on 29 July 1994, show that
5 Dr. Chatterjee had obtained a DNA molecule that encoded a
6 mutant protein having the required tyrosine-for-
7 phenylalanine substitution and DNA polymerase activity.

8 61. Chatterjee asserts that the declaration of Adam
9 Goldstein and of Harini Shandilya, together with
10 Dr. Chatterjee's notebooks, "as interpreted with
11 particularity" in their declarations, corroborate the
12 actual reduction to practice of the Taq F667Y mutant enzyme
13 on 29 July 1994. (Paper 65 at 15-16.)

14 62. In its principal brief, Chatterjee does not direct our
15 attention to particular statements in the declarations,
16 laboratory notebooks, or other documents that may have been
17 prepared by Goldstein or Shandilya, in support of its
18 Taq F667Y actual reduction to practice argument. (Paper 65
19 at 14-16.)

20 63. Facts 837 and 838, mentioned above as the only
21 statement of facts mentioned by Chatterjee in this portion

1 of its argument, are silent as to corroborating statements
2 by Goldstein or Shandilya.

3 Abandon, Suppress, or Conceal

4 64. Chatterjee argues that it did not abandon, suppress,
5 or conceal its invention from either 12 September 1991, or
6 29 July 1994 (its two alleged actual reductions to
7 practice) and 8 September 1995 (its filing date and
8 constructive reduction to practice). (Paper 65 at 18-22.)

9 65. Chatterjee asserts that there was "a coordinated
10 effort by Dr. Chatterjee and other scientists under his
11 direction to develop isolated polynucleotides encoding
12 mutant DNA polymerases comprising the FY mutation recited
13 in the Chatterjee claims" (Paper 65 at 20, citing
14 Facts 99-1198.)

15 66. In Chatterjee's words, "[t]he coordinated effort
16 comprised: (a) isolation of DNA polymerase genes from a
17 variety of thermostable and nonthermostable organisms;
18 (b) introduction of mutations into certain of those
19 isolated polymerase genes; and (c) production and
20 characterization of the enzymatic activities of the mutant
21 DNA polymerases encoded by those genes." (Paper 65
22 at 20-21, citing Facts 99-1198.)

1 67. Chatterjee urges that these activities were "directed
2 toward perfecting the invention that ultimately was the
3 subject of Party Chatterjee's involved patent application."
4 (Paper 65 at 21.)

5 68. Chatterjee does not, in its principal brief, make any
6 significant attempt to relate any of the activities said to
7 comprise its "coordinated effort" to the limitations of its
8 involved claims or to disclosures in its involved
9 specification.

10 Discussion

11 The statute governing interferences reads, in relevant
12 part:

13 A person shall be entitled to a patent unless—
14 * * * during the course of an interference
15 conducted under section 135 . . . another
16 inventor involved therein establishes, to the
17 extent permitted in section 104, that before such
18 person's invention thereof, the invention was
19 made by such other inventor and not abandoned,
20 suppressed, or concealed. . . . In determining
21 priority of invention under this subsection,
22 there shall be considered not only the respective
23 dates of conception and reduction to practice of
24 the invention, but also the reasonable diligence
25 of one who was first to conceive and last to
26 reduce to practice, from a time prior to
27 conception by the other.

28 35 U.S.C. § 102(g)(1). In the present case, Chatterjee has
29 not tried to show that it was diligent. Accordingly, we
30 need consider only whether Chatterjee has carried its

1 burden of establishing a date of actual reduction to
2 practice prior to Tabor's accorded benefit date. "Proof of
3 actual reduction to practice requires satisfaction of a two
4 pronged test: (1) the party must have constructed an
5 embodiment that met every element of the interference count,
6 and (2) the embodiment must have operated for its intended
7 purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d
8 1696, 1698 (Fed. Cir. 2000).

9 Evidence submitted in a contested case in support of
10 motions must conform to the Federal Rules of Evidence.
11 Bd.R. 152. The requirements for testimony as to
12 specialized matters are also specified by regulation:

13 (a) Expert testimony that does not disclose the
14 underlying facts or data on which the opinion is
15 based is entitled to little or no weight.
16 Testimony on United States patent law will not be
17 admitted.

18 (b) If a party relies on a technical test or data
19 from such a test, the party must provide an
20 affidavit explaining:

21 (1) Why the test or data is being used,

22 (2) How the test was performed and the data
23 was generated,

24 (3) How the data is used to determine a
25 value,

26 (4) How the test is regarded in the relevant
27 art, and

1 (5) Any other information necessary for the
2 Board to evaluate the test and data.
3 Bd.R. 158. Moreover, testimony or other evidence offered
4 solely by an inventor is entitled to no weight unless it is
5 corroborated. *Brown v. Barbacid*, 276 F.3d 1327, 1335, 61
6 USPQ2d 1236, 1240 (Fed. Cir. 2002) ("an inventor's
7 testimonial assertions of inventive facts require
8 corroboration by independent evidence.")

9 As a preliminary matter, we note that both of
10 Chatterjee's alleged dates of actual reduction to practice,
11 9 September 1991, and 29 July 1994, are prior to 11 August
12 1994, the date Tabor alleged in its priority statement as
13 its earliest corroborated actual reduction to practice.
14 (Paper 28 at 1.) Thus, if Chatterjee's motion were to be
15 granted, Tabor would not be entitled to a patent to its
16 involved claims. On the other hand, if Chatterjee does not
17 carry its burden, Tabor, as the senior party, is presumed
18 to be the prior inventor. Bd.R. 207(a)(1).

19 Chatterjee argues that John Hughes and Dr. Chatterjee
20 obtained an actual reduction to practice of the T5 F570Y
21 mutant on 12 September 1991 by showing that the prepared
22 molecule had polymerase activity. (Paper 65 at 13.)
23 Chatterjee cites only Facts 99 and 100 in support of its

1 actual reduction to practice. (Paper 65 at 13.) Facts 99

2 and 100 read in their entirety as follows:

3 99. On or about September 12, 1991, John Hughes
4 performed experiments to purify and analyze and
5 analyze [sic] E. coli DNAP (JH19). This activity
6 was recorded on page[s] 89-92 of notebook 3048.
7 Exhibit CX2007, pages 89-92.

8 100. On or about September 12, 1991, Deb
9 Chatterjee preformed [sic] a series of
10 experiments to test the enzymatic activity of the
11 mutated pSport T5 polymerase, indicating a 4 fold
12 higher specific activity in induced clone 4 over
13 the uninduced clone, and 2-3 fold higher specific
14 activity of induced clone 7 over the uninduced
15 clone. I also performed a restriction
16 endonuclease assay of pSport T5 and identified
17 that the clones were mutated and in the correct
18 orientation. These experiments are recorded on
19 page 45 of notebook 3128. Exhibit CX 2009,
20 page 45.

21 (Paper 65 at 51.) Notebook #3048 appears to have been
22 issued to Hughes. (CX 2007 at pdf3.) Notebook #3128
23 appears to have been issued to Dr. Chatterjee. (CX 2009
24 at pdf3.)

25 Chatterjee, in its principal brief, does not direct
26 our attention to any credible testimony that explains, on
27 the basis of the notebook disclosures, how the experiments
28 were conducted, how any values reported were determined
29 from the raw data, and why those skilled in the art would
30 consider those experiments to be a reasonable proof that
31 the polymerases worked for their intended purpose. We have

1 reviewed notebook #3048, pages 89-92 (CX 2007, 89-92 and
2 three extra pages apparently inserted between pages 90
3 and 91 in the original notebook) and notebook #3128,
4 page 45 (CX 2009 at 45), but find they do not "speak for
5 themselves," at least to us. They are too terse to enable
6 us, non experts in this art, to make findings of fact as to
7 their meaning or importance in support of the alleged
8 actual reduction to practice on 12 September 1991.⁵ Absent
9 testimony explaining experiments in accord with Bd.R. 158,
10 and, if the opposing party sees fit to file it, cross-
11 examination testimony of the declarant, we are seldom in a
12 position to evaluate the evidence on which a party relies
13 to support its case. Under such circumstances, we are
14 constrained to accord such evidence no weight. Thus,
15 Chatterjee's failure to timely present and explain⁶ the
16 evidence on which it relies is sufficient reason to deny

⁵ We are able to determine, however, that at least the first sentence of Fact 100 is not true: Dr. Chatterjee did not conduct experiments to test the activity of "the mutated pSport T5 polymerase." CX 2009, page 45, indicates that the samples were given to "J. Hughes" for analysis. Chatterjee's inaccurate handling of its own record decreases still further our confidence in the force of its arguments.

⁶ At oral argument, Chatterjee pointed to a declaration signed by Professor Myron F. Goodman (CX 2075) as supporting its *prima facie* case. (Paper 107 at 20, l. 18ff.) As the panel noted then (*id.* at 21, l. 16, through 22, l. 7), Chatterjee's principal brief on priority was filed [on 11] July 2006, whereas Dr. Goodman did not sign his declaration until 12 October 2006. Dr. Goodman's testimony comes too late to support Chatterjee's case-in-chief, and we shall not consider it.

1 Chatterjee Motion 1 as to proof of an actual reduction to
2 practice on 12 September 1991.⁷

3 A party's brief must not only refer specifically to
4 evidence in support of its position—it must (when, as here,
5 it is necessary) explain the evidence and explain why that
6 evidence supports the relief it has requested. In other
7 words, a party must argue its case. The Board will not act
8 as an advocate for a party that has failed to argue its
9 case.

10 In our experience, laboratory notebooks recording
11 specialized experiments rarely "speak for themselves" to
12 non-specialist readers. These notebooks are no exception.
13 Outside of some of Hughes' entries, there are few, if any,
14 indications to the non-expert reader precisely what were
15 the goals of the experiments. Similarly, there are few, if
16 any, indications of whether those goals were achieved. Not
17 surprisingly, because this is not normally the purpose of a
18 laboratory notebook, there appear to be no explanations of
19 how the experiments worked, or how the results were
20 obtained and interpreted. Chatterjee's burden to explain,
21 with the assistance of a knowledgeable witness, its

⁷ Moreover, Chatterjee, in its principal brief, does not direct our attention to any credible testimony or evidence corroborating Dr. Chatterjee's notebook, i.e., his alleged recognition, on 12 September 1991, of the actual reduction to practice.

1 evidence, is dictated by common principles of fairness.
2 Chatterjee's mode of argument, if permitted, would unfairly
3 burden the other party by forcing them to hypothecate the
4 strongest argument Chatterjee could make from Chatterjee's
5 own record, and to then set about evaluating and developing
6 evidence to support an argument opposing the hypothetical
7 substantive motion. Similarly, while the Board is fairly
8 charged with understanding and evaluating a well-posed and
9 well-supported argument, it is under no obligation to
10 shoulder the burden of divining what arguments a movant
11 intended to make based on the evidence presented.
12 Administrative Patent Judges are adjudicators, not
13 advocates.

14 Because Chatterjee does not argue diligence, we need
15 not and do not consider Chatterjee's case for conception on
16 14 June 1991.

17 In summary, we determine that Chatterjee has failed to
18 prove an actual reduction to practice of an embodiment
19 within the scope of the Count on 12 September 1991.

20 Chatterjee argues that it has demonstrated a second
21 actual reduction to practice no later than 29 July 1994,
22 when Dr. Chatterjee received an oligonucleotide synthesized

1 for him having the stated purpose of making an F667Y
2 mutation in Taq DNA polymerase. (Paper 65 at 14.)
3 According to Chatterjee, after Dr. Chatterjee received the
4 oligonucleotide, he performed an oligonucleotide directed
5 mutagenesis on the Taq polymerase gene and obtained a clone
6 incorporating the mutant sequence. (Paper 65 at 14.)
7 Chatterjee argues that the identity of the clone was
8 confirmed by demonstration of an additional AseI
9 restriction site derived from the oligonucleotide.
10 (Paper 65 at 14.) Chatterjee argues further that
11 thermostable polymerase activity was demonstrated by
12 incorporating an "NgoAIV - XbaI restriction fragment into
13 an "inducible expression vector," which was transformed
14 into bacteria. According to Chatterjee, expression was
15 induced, and an assay of the resulting culture showed
16 thermostable polymerase activity. (Paper 65 at 15.)

17 The only evidence that Chatterjee cites in its
18 principal brief in support of an actual reduction to
19 practice on 29 July 1994 are Facts 837 and 838. (Paper 65
20 at 14.) Facts 837 and 838 cite a request for synthesis of
21 two oligonucleotides (CX 2062), Dr. Chatterjee declaration
22 (CX 2043, ¶¶ 90 and 91), and LTI notebook #3573 (CX 2021
23 at 166). (Paper 65 at 260-61, ¶¶ 837-38.) Our review of

1 exhibit CX 2062 persuades us that it is fairly
2 characterized as a request for synthesis of an
3 oligonucleotide. However, our review of Dr. Chatterjee's
4 declaration (CX 2043) and notebook (CX 2021 at 166) does
5 not permit us to conclude that he performed, on 29 July
6 1994, any of the experiments Chatterjee asserts showed the
7 invention worked for its intended purpose. We find no
8 indication of a demonstration on that date of an AseI
9 restriction site in the purported DNA polymerase molecule
10 or that the purported DNA polymerase molecule exhibited
11 thermostable polymerase activity. Indeed, as near as we
12 can tell from notebook page 166, and as Chatterjee
13 confirmed at oral argument⁸, all Dr. Chatterjee had on
14 29 July 1994 was the oligonucleotide he had ordered.
15 Dr. Chatterjee did not have the complete DNA molecule
16 encoding a DNA polymerase as recited in the Count, not to
17 mention the protein coded for by that DNA, that could be
18 tested for any of its properties. At oral argument,
19 Chatterjee urged that proof of an actual reduction to
20 practice merely requires proof of "possession" of the
21 invention (Paper 107 at 14, ll. 14-19), apparently as that

⁸ Paper 107 at 11, l. 22, through 12, l. 3:

Q: What's the date of the actual reduction to practice?
Mr. McCabe: July 29 when the oligo was made.

1 term is used in discussions of written description. This
2 argument is utterly without merit. Chatterjee appears to
3 have conflated the requirement for conception with the
4 requirement for actual reduction to practice. The term
5 "actual" in "actual reduction to practice" means exactly
6 what it says. Thus, we reject Chatterjee's proof of an
7 actual reduction to practice on 29 July 1994.

8 Because Chatterjee has failed to establish a *prima*
9 *facie* case for an actual reduction to practice, we need not
10 consider Chatterjee's position that Goldstein and Shandilya
11 provided adequate corroboration. Similarly, we need not
12 consider Chatterjee's arguments that it did not abandon,
13 suppress, or conceal its invention.

14 Chatterjee's motion that it proved an actual reduction
15 to practice of an embodiment within the scope of the Count
16 on 29 July 1994, fails for lack of any credible supporting
17 evidence.

18 Chatterjee has failed to show, by a preponderance of
19 the evidence, that it actually reduced to practice an
20 embodiment of the Count prior to Tabor's accorded benefit
21 date. Chatterjee has not alleged, in its principal brief,
22 diligence from a date prior to Tabor's earliest conception

1 through a reduction to practice, whether actual or
2 constructive. Thus, there is no basis on which Chatterjee
3 can overcome Tabor's status as the senior party in this
4 interference.

5 Accordingly, Tabor's motions are moot. Because we
6 need not and do not reach Tabor's motions, Chatterjee's
7 motion 2, to exclude certain evidence, is also moot.

8 Judgment adverse to Chatterjee is entered in Paper 109,
9 mailed on the same date as this Decision.

10 IV. Order

11 For the reasons given *supra*, it is

12 ORDERED that Chatterjee Motion 2 for priority is
13 DENIED.

14 FURTHER ORDERED that Chatterjee Motion 3 is
15 DISMISSED.

16 FURTHER ORDERED that Tabor Motion 2 is DISMISSED.

17 FURTHER ORDERED that Tabor Motion 3 is DISMISSED.

18 FURTHER ORDERED that Tabor Motion 4 is DISMISSED.

19 FURTHER ORDERED that a copy of the DECISION shall
20 be entered into the records of Application 09/558,421 and
21 U.S. Patent 5,614,365.

1 FURTHER ORDERED that in the event of a settlement,
2 the attentions of the parties are drawn to 35 U.S.C.
3 § 135(c) and Bd.R. 205.
4

/Romulo H. Delmendo/)
ROMULO H. DELMENDO)
Administrative Patent Judge)

/Sally Gardner Lane/) BOARD OF PATENT
SALLY GARDNER LANE) APPEALS AND
Administrative Patent Judge) INTERFERENCES

/Mark Nagumo/)
MARK NAGUMO)
Administrative Patent Judge)

Interference 105,292
Chatterjee v. Tabor

Paper 108

cc (via Overnight mail):

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112.001

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

INVITROGEN CORPORATION, a Delaware
Corporation,

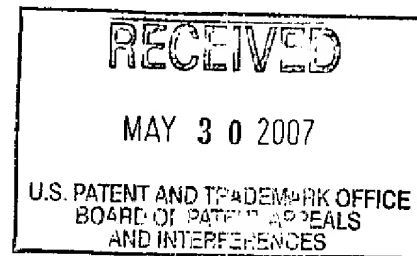
Plaintiff,

v.

PRESIDENT AND FELLOWS OF
HARVARD COLLEGE, a Massachusetts
Corporation,

Defendant.

Civil Action No.



COMPLAINT

Plaintiff Invitrogen Corporation ("Invitrogen") for its complaint against the defendant President and Fellows of Harvard College ("Harvard"), states as follows:

THE NATURE OF THE ACTION

1. This is a civil action to remedy the decisions and judgment of the Board of Patent Appeals and Interferences ("Board") of the United States Patent and Trademark Office ("USPTO") adverse to party Chatterjee in Interference No. 105,292, titled "Deb K. Chatterjee, Junior Party (Application 09/558,421) v. Stanley Tabor and Charles Richardson, Senior Party (Patent 5,614,365)" as provided for by 35 U.S.C. § 146.

THE PARTIES

2. Invitrogen is a corporation organized and existing under the laws of the state of Delaware, having its principal place of business at 1600 Faraday Avenue, Carlsbad, California 92008.

3. Upon information and belief, Harvard is a corporation organized and existing under the laws of the State of Massachusetts, having its principal place of business at 1033 Massachusetts Avenue, 3rd Floor, Cambridge, Massachusetts 02138.

JURISDICTION AND VENUE

4. Jurisdiction is based on 28 U.S.C. §§ 1331 and 1338 and 35 U.S.C. § 146.

5. Venue is proper in this judicial district under 28 U.S.C. § 1391.

CLAIM FOR RELIEF

(Civil Action under 35 U.S.C. § 146)

6. Invitrogen realleges and incorporates by reference paragraphs 1-5 of this Complaint.

7. On April 6, 2005, the USPTO declared an interference, designated as Interference No. 105,292 ("the '292 interference"), under 35 U.S.C. § 135(a) between United States Patent Application Serial No. 09/558,421 ("the Chatterjee '421 application") and United States Patent No. 5,614,365 ("the Tabor '365 patent").

8. The Chatterjee '421 application and the Tabor '365 patent generally relate to molecular cloning and expression of mutant DNA polymerases.

9. In declaring the '292 interference the USPTO determined that certain claims of the Chatterjee '421 application and the Tabor '365 patent interfere because they claim common subject matter. The '292 interference is based on a single "count" that defines the interfering subject matter in the alternative: claim 1 of the Chatterjee '421 application or claim 1 of the Tabor '365 patent. Only the first inventor of subject matter corresponding to the count is entitled to patent claims directed to that subject matter.

10. The USPTO designated claims 1-6 and claims 15-20 of the Chatterjee '421 application as corresponding to the count.

11. Deb K. Chatterjee is the first inventor of the subject matter of claims 1-6 and claims 15-20 of the Chatterjee '421 application, which is entitled to priority under 35 U.S.C. § 120 to the priority benefit of the filing date of Chatterjee's priority applications, namely, United States Patent Application Serial No. 08/576,759, filed December 21, 1995 ("the Chatterjee '759 application"), United States Patent Application Serial No. 08/537,397, filed October 2, 1995 ("the Chatterjee '397 application"), and United States Patent Application Serial No. 08/525,057, filed September 8, 1995 ("the Chatterjee '057 application").

12. The entire right, title, and interest in and to the Chatterjee '421, the Chatterjee '759 application, the Chatterjee '397 application, and the Chatterjee '057 application have been assigned to Invitrogen, which, for the purposes of this action, is the real party in interest for said applications.

13. The USPTO designated claims 1-3, 5-11, 32, 40, 55, 56, 63, 69, and 70 of the Tabor '365 patent as corresponding to the count.

14. Upon information and belief, Stanley Tabor and Charles Richardson claim to be the inventors of the subject matter of claims 1-3, 5-11, 32, 40, 55, 56, 63, 69, and 70 of the Tabor '365 patent, which purports to be entitled to the benefit under 35 U.S.C. § 120 of United States Patent Application Serial No. 08/324,437, filed October 17, 1994 ("the Tabor '437 application"), now abandoned.

15. Upon information and belief, Stanley Tabor and Charles Richardson have assigned all rights in the Tabor '365 patent and the Tabor '437 application to Harvard, which, for the purposes of this action, is the real party in interest for the Tabor '365 patent.

16. During the '292 interference and on March 15, 2007, the Board mailed and filed paper no. 109, titled "Judgment – Merits – Bd. R. 127" (attached hereto as Exhibit A), which reads in part: "ORDERED that judgment is entered against Chatterjee; FURTHER ORDERED that Deb. K. Chatterjee is not entitled to a patent to claims 1-6 and 15-20 of Application 09/558,421, which correspond to Count 1 and which are all the claims of the application."

17. During the '292 interference and on March 15, 2007, the Board mailed and filed paper no. 108, titled "Decision – Priority – Bd. R. 125(a)" (attached hereto as Exhibit B), which reads in part: "ORDERED that Chatterjee Motion 2 for priority is denied."

18. The Board's decisions or judgment in the '292 interference were based upon several erroneous determinations adverse to party Chatterjee, including, but not limited to, those set forth in paragraphs 19-21 of this Complaint.

19. During the '292 interference and on March 15, 2007, the Board erroneously determined that Chatterjee failed to show, by a preponderance of the evidence, that Chatterjee actually reduced to practice an embodiment of the Count prior to Tabor's accorded benefit date.

20. During the '292 interference and on March 15, 2007, the Board erroneously determined that Chatterjee failed to show, by a preponderance of the evidence, an actual reduction to practice of an embodiment within the scope of the Count on September 12, 1991.

21. During the '292 interference and on March 15, 2007, the Board erroneously determined that Chatterjee failed to show, by a preponderance of the evidence, an actual reduction to practice of an embodiment within the scope of the Count on July 29, 1994.

22. Upon information and belief, no party to the '292 interference has appealed the decision of the Board to the United States Court of Appeals for the Federal Circuit.¹

PRAYER

WHEREFORE, Invitrogen prays for a judgment:

1. Reversing all portions of the Board's decisions or judgment adverse to Chatterjee including reversing the Board's decisions of March 15, 2007 against Chatterjee: that Deb. K. Chatterjee is not entitled to a patent to claims 1-6 and 15-20 of the Chatterjee '421 application, and that Chatterjee failed to show, by a preponderance of the evidence, an actual reduction to practice of an embodiment within the scope of the Count prior to the earliest accorded benefit date of the Tabor '365 patent.

2. Adjudging that Deb K. Chatterjee is the first inventor of the invention defined by the count and that Invitrogen is entitled to a patent of the United States for said invention;

¹ Invitrogen has filed a civil action in the District Court for the Southern District of California involving the same parties and allegations. Invitrogen files the Massachusetts action to preserve its ability to appeal the decision of the United States Patent and Trademark Office in the '292 interference if jurisdiction or venue is not proper in the Southern District of California. As required by 35 U.S.C. § 146 and 37 C.F.R. § 1.304, the actions filed in this Court and in California have been filed within two months of the date of the decision of the United States Patent and Trademark Office in the '292 interference.

3. Determining that all claims of the Tabor '365 patent corresponding to the count are unpatentable to Tabor;
4. Entering judgment for Invitrogen and against Harvard in the '292 interference;
5. Declaring this action an exceptional case;
6. Awarding Invitrogen its costs in this action, including its reasonable attorneys' fees; and
7. Awarding Invitrogen such other and further relief as the Court may deem just and proper.

JURY TRIAL DEMAND

Invitrogen hereby demands a trial by jury on all issues so triable.

Dated: May 15, 2007

Respectfully submitted,

INVITROGEN CORPORATION
By its attorneys,

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Invitrogen Corporation
v.
President and Fellows of Harvard College

EXHIBIT A
TO COMPLAINT

Paper 109

Filed by Trial Division Motions Panel
Mail Stop Interference
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Alexandria VA 22313-1450
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Filed:
March 15, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEB K. CHATTERJEE
Junior Party,
(Application 09/558,421),

v.

STANLEY TABOR
and CHARLES RICHARDSON,
Senior Party,
(Patent 5,614,365).

MAILED

MAR 15 2007

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 105,292

Before Delmendo, Lane, and Nagumo, Administrative Patent
Judges.

Nagumo, Administrative Patent Judge.

1 **Judgment - Merits - Bd.R. 127**

2 For the reasons set out in the Decision, Paper 108,
3 mailed on the same date as this JUDGMENT, it is:

4 ORDERED that adverse judgment is entered against
5 Chatterjee;

6 FURTHER ORDERED that Deb K. Chatterjee is not
7 entitled to a patent to claims 1-6 and 15-20 of Application

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1 09/558,421, which correspond to Count 1 and which are all
2 the claims of the application.

3 FURTHER ORDERED that a copy of this JUDGMENT
4 shall be entered into the records of Application 09/558,421
5 and U.S. Patent 5,614,365.

6 FURTHER ORDERED that in the event of a settlement,
7 the attentions of the parties are drawn to 35 U.S.C.
8 § 135(c) and Bd.R. 205.

9

/Romulo H. Delmendo/)
ROMULO H. DELMENDO)
Administrative Patent Judge)

/Sally Gardner Lane/) BOARD OF PATENT
SALLY GARDNER LANE) APPEALS AND
Administrative Patent Judge) INTERFERENCES

/Mark Nagumo/)
MARK NAGUMO)
Administrative Patent Judge)

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Invitrogen Corporation
v.
President and Fellows of Harvard College

EXHIBIT B
TO COMPLAINT

Paper 108.

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Filed:
March 15, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEB K. CHATTERJEE
Junior Party,
(Application 09/558,421),

v.

STANLEY TABOR
and CHARLES RICHARDSON,
Senior Party,
(Patent 5,614,365).

MAILED

MAR 15 2007

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 105,292

Before Delmendo, Lane, and Nagumo, Administrative Patent Judges.

Nagumo, Administrative Patent Judge.

1 **Decision - Priority - Bd. R. 125(a)**

2 I. Introduction

3 The subject matter of this interference relates to the
4 discovery of a class of mutant DNA polymerase enzymes. The
5 critical mutation is the substitution in the DNA polymerase
6 of a single tyrosine residue for a specific phenylalanine
7 residue, which is equivalent to adding an -OH ("hydroxyl")

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1 group to the phenyl group of the phenylalanine residue.
2 The tyrosine mutation resulted in the ability of the
3 mutated enzyme to incorporate dideoxynucleotides into the
4 DNA molecule about as efficiently as deoxynucleotides.
5 Once a dideoxynucleotide is incorporated into the DNA, the
6 polymerization can no longer continue and the chain is
7 terminated. For fascinating reasons that need not delay
8 our consideration of the issues before us, the principal
9 practical interest of the disputed enzymes is that they
10 enabled the transformation of DNA sequencing by the "chain
11 termination method" from an expensive laboratory technique
12 yielding results that could be difficult to evaluate into
13 an inexpensive, powerful, and widely used analytical tool.
14 (See, e.g., Second Declaration of I. Robert Lehman, Ph.D.,
15 TX 1028 at 2, ¶ 7, through 4, ¶ 9; "I am confident that the
16 rapid progress and success of the human genome project seen
17 in the mid to late '90s and early 2000's was to a
18 significant extent dependent on the DNA polymerase [of this
19 interference]." *Id.* at 4, ¶ 9, last sentence.)

20 The parties have filed motions for priority. Tabor
21 has also filed a motion for judgment, deferred from the
22 interlocutory phase of this interference (Paper 27 at 2),
23 that Junior Party Chatterjee's claims are anticipated by

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1 disclosures by Tabor. Both parties have moved to exclude
2 certain evidence.

3 Oral argument was heard 5 March 2007 (transcript,
4 Paper 107). Kevin W. McCabe, Esq., argued for Chatterjee.
5 Richard J. Warburg, Esq., argued for Tabor.

6 For the reasons set out post, we hold that junior
7 party Chatterjee has failed to establish in its principal
8 brief a *prima facie* case that it was first to reduce to
9 practice an embodiment within the scope of the Count.
10 Accordingly, as Chatterjee did not argue diligence, we DENY
11 Chatterjee's motion for priority. As there is no way
12 Chatterjee can prevail in this interference, we DISMISS the
13 remaining motions of both parties as moot. Judgment is
14 entered separately in Paper 109, which is mailed on the
15 same date as this Decision.

16 II. Findings of Fact

17 The following findings of fact and those set out in
18 the Discussion are supported by a preponderance of the
19 evidence of record.

20 Junior Party Chatterjee

21 1. Deb K. Chatterjee (Dr. Chatterjee) is the named
22 inventor for Chatterjee.

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1 2. Chatterjee is involved on the basis of application
2 09/558,421 (TX 1006)¹, which was filed 26 April 2000,
3 as a Continuation of
4 08/576,759 (TX 1005), filed 21 December 1995, now
5 abandoned, which was filed as a Continuation of
6 08/537,397 (TX 1004), filed 2 October 1995, now
7 abandoned, which was filed as a Continuation-in-Part of
8 08/525,057 (TX 1003), filed 8 September 1995, now
9 abandoned.

10 3. Chatterjee has been accorded the benefit for priority
11 of each of the above-listed applications. (Paper 1 at 4.)

12 4. The real-party-in-interest for Chatterjee is
13 identified as Invitrogen Corp. (Paper 7 at 2.)

14 5. Invitrogen Corp. is said to be the "surviving entity"
15 of a merger between Invitrogen Corp. and Life Technologies,
16 Inc. ("LTI"), the company for which Dr. Chatterjee and
17 numerous fact witnesses worked at the relevant times.
18 (SX 2043 at 1 n.1.)

19 Senior Party Tabor

20 6. Stanley Tabor and Charles Richardson are the named
21 inventors for Tabor.

¹ Chatterjee exhibits are referred to as "CX 2xxx", while Tabor exhibits are referred to as "TX 1xxx".

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1 7. Tabor is involved on the basis of U.S. Patent
2 5,614,365 (TX 1039), issued 25 March 1997, which is based
3 on
4 08/337,615, filed 10 November 1994, as a Continuation-
5 in-Part of
6 08/324,437 (TX 1027), filed 17 October 1994, now
7 abandoned.

8 8. Tabor has been accorded the benefit for priority of
9 each of the above-listed applications. (Paper 1 at 4.)

10 9. The real-party-in-interest for Tabor is identified as
11 the President and Fellows of Harvard College. The United
12 States Department of Energy is identified as having a
13 nonexclusive license. (Paper 11 at 1.)

14 The Count

15 10. The sole count in this interference is:

16 Claim 1 of Chatterjee (09/558,421)

17 or

18 Claim 1 of Tabor (5,614,365).

19 (Paper 1 at 5.)

20 11. Claim 1 of Chatterjee reads (line breaks and
21 indentation added):

22 A DNA molecule comprising

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1 a coding sequence for a mutant protein,
2 wherein said mutant protein is a mutant DNA
3 polymerase selected from the group consisting of:
4 *E. coli* DNA polymerase I,
5 Klenow fragment of *E. coli* DNA polymerase I,
6 *Streptococcus pneumoniae* polymerase,
7 *Thermus aquaticus* polymerase,
8 *Thermus flavus* polymerase,
9 *Thermus thermophilus* polymerase,
10 *Deinococcus radiodurans* polymerase,
11 *Bacillus caldotenax* polymerase,
12 *E. coli* bacteriophage T5 polymerase,
13 mycobacteriophage L5 polymerase,
14 *Thermatoga maritima* polymerase, and
15 *E. coli* bacteriophage SP01 polymerase,
16 wherein said mutant DNA polymerase comprises
17 a substitution of Tyr for Phe at a position
18 in said polymerase corresponding to Phe570
19 of wild-type T5 polymerase.

20 (Paper 5 at 3.)

21 12. A merits panel of the Board held that a DNA covered by
22 Chatterjee claim 1 must encode a protein that polymerizes
23 DNA. (Paper 57 at 15.)

24 13. Claim 1 of Tabor 5,614,365 reads:

25 Modified gene encoding a modified Pol I-type DNA
26 polymerase
27 wherein said modified gene is modified to encode
28 a tyrosine residue at an amino acid position
29 corresponding to T7 DNA polymerase residue 526 or
30 at an amino acid position corresponding to
31 *E. coli* DNA polymerase residue 762 in its dNMP
32 binding site
33 to increase ability of said modified DNA
34 polymerase to incorporate a dideoxynucleotide
35 relative to a corresponding deoxynucleotide
36 compared to the ability of a corresponding

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1 naturally-occurring unmodified DNA polymerase by
2 at least 20-fold.

3 (Paper 12 at 1.)

4 14. The claims of the parties are:

5 Chatterjee: 1-6 and 15-20

6 Tabor: 1-108

7 15. The claims of the parties that correspond to the Count
8 and that are involved in this interference are:

9 Chatterjee: 1-6 and 15-20

10 Tabor: 1-3, 5-11, 32, 40, 55, 56, 63, 69,
11 and 70.

12 16. The claims of the parties that do NOT correspond to
13 the Count and that are NOT involved in this interference
14 are:

15 Chatterjee: none

16 Tabor: 4, 12-31, 33-39, 41-54, 57-62,
17 64-68, and 71-108.

18 Chatterjee Motions

19 17. Chatterjee Motion 1 (Paper 65) seeks judgment for
20 priority. Tabor opposed (Paper 80) and Chatterjee replied
21 (Paper 87).

22 18. Chatterjee Motion 2 (Paper 89) seeks to exclude
23 certain exhibits. Tabor opposed (Paper 97) and Chatterjee
24 replied (Paper 98).

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1 Tabor Motions

2 19. Tabor Motion 2 (Paper 75) seeks judgment that all of
3 Chatterjee's involved claims are anticipated under 35 U.S.C.
4 §§ 102(a) or (e). Chatterjee opposed (Paper 77) and Tabor
5 replied (Paper 81).

6 20. Tabor Motion 3 (Paper 76) seeks judgment for priority,
7 including judgment that Chatterjee derived the invention
8 from Tabor. Chatterjee opposed (Paper 78) and Tabor
9 replied (Paper 82).

10 21. Tabor Motion 4 (Paper 92) seeks to exclude certain
11 exhibits. Chatterjee opposed (Paper 96) and Tabor replied
12 (Paper 99).

13 Priority Statements

14 22. Chatterjee asserts in its priority statement an
15 earliest corroborated actual reduction to practice date of
16 10 September 1991. (Paper 37 at 2.)

17 23. Chatterjee asserts in its priority statement an
18 earliest corroborated conception date of 14 June 1991.
19 (Paper 37 at 2.)

20 24. Tabor asserts in its priority statement an earliest
21 corroborated actual reduction to practice date of 11 August
22 1994. (Paper 28 at 1.)

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1 25. Tabor asserts in its priority statement an earliest
2 corroborated conception date of 2 October 1993. (Paper 28
3 at 1.)

4 Chatterjee Motion 1 (Priority)

5 26. Chatterjee moves for judgment that it was the first to
6 conceive and the first to reduce to practice based on two
7 different embodiments within the scope of the Count.
8 (Paper 65 at 10 and 14.)

9 27. Chatterjee argues that it actually reduced to practice
10 embodiments of the invention no later than 12 September
11 1991, and no later than 29 July 1994. (Paper 65 at 13-14.)

12 28. Chatterjee argues further that it did not abandon,
13 suppress, or conceal its invention. (Paper 65 at 19.)

14 29. Chatterjee makes no attempt in its principal brief to
15 prove diligence from conception through an actual or
16 constructive reduction to practice.

17 First embodiment: T5 F570Y mutant

18 30. Chatterjee argues that an actual reduction to practice
19 of a T5 DNA polymerase F570Y mutant, in which, *inter alia*,
20 the phenylalanine ("F") at amino acid residue position 570,

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1 was replaced by tyrosine ("Y"), was done on 12 September
2 1991, by Dr. John Hughes ("Hughes") and Dr. Chatterjee.

3 31. According to Chatterjee, on that date, Hughes and
4 Dr. Chatterjee showed that the prepared molecule had
5 polymerase activity. (Paper 65 at 13.)

6 32. Chatterjee cites Facts 99 and 100 in support of its
7 actual reduction to practice. (Paper 65 at 13.)

8 33. Fact 99 reads:

9 99. On or about September 12, 1991, John Hughes
10 performed experiments to purify and analyze and
11 analyze [sic] E. coli DNAP (JH19). This activity
12 was recorded on page[s] 89-92 of notebook 3048.
13 Exhibit CX2007, pages 89-92.

14 (Paper 65 at 51.)

15 34. Fact 100 reads:

16 100. On or about September 12, 1991, Deb
17 Chatterjee preformed [sic] a series of
18 experiments to test the enzymatic activity of the
19 mutated pSport T5 polymerase, indicating a 4 fold
20 higher specific activity in induced clone 4 over
21 the uninduced clone, and 2-3 fold higher specific
22 activity of induced clone 7 over the uninduced
23 clone. I also performed a restriction
24 endonuclease assay of pSport T5 and identified
25 that the clones were mutated and in the correct
26 orientation. These experiments are recorded on
27 page 45 of notebook 3128. Exhibit CX 2009,
28 page 45.

29 (Paper 65 at 51.)

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1 35. Exhibit CX 2007 is presented as LTI notebook #3048,
2 issued to John Hughes on 11 February 1991. (CX 2007
3 at pdf3².)

4 36. Exhibit CX 2009 is presented as LTI notebook #3128,
5 issued to Deb Chatterjee on 16 May 1991, entitled "T5 DNA
6 Polymerase." (CX 2009 at pdf3.)

7 37. Chatterjee, in its principal brief, does not direct
8 our attention to any inventor testimony, nor to any
9 corroborating testimony by non-inventors, in support of the
10 alleged actual reduction to practice on 12 September 1991.

11 38. Reviewing the notebook pages and declarations cited by
12 Chatterjee in Statements of Material Fact 99 and 100, we
13 find, albeit without the benefit of any guiding testimony,
14 that:

15 a. In notebook #3048, at pages 89-92, Hughes
16 recorded Experiment JH-19, the purpose of which was,
17 in his words, to "[t]est Deb Chatterjees 4 amino acid
18 point mutation of T5 DNA polymerase for activity."³
19 (CX 2007 at 89.)

² Citations to Party Chatterjee's notebook pages are to the number printed on the page. Covers, title pages, etc., are not numbered, and are cited by the page number in the pdf file provided by Chatterjee on the CD-ROM disk.

³ All of Hughes' entries are in capital letters, not reproduced here for ease of reading.

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1 b. At page 90 of notebook #3048, Hughes wrote under
2 a table of assays of cell lysates, "Sample #4 shows a
3 2-fold enhancement in activity over the uninduced
4 control. This may not be significant however."

5 (CX 2007 at 90.)

6 c. There does not appear to be a comparable
7 statement regarding the activity of Sample #7 on
8 notebook #3048 pages 89-92.

9 d. Dr. Chatterjee appears to have recorded the
10 results of Hughes' experiments in notebook #3128 at
11 page 45:

12 Gave all 4 Samples to J. Hughes

13 * * *

14 The results indicate that Sp. activity of #4
15 induced clone was 4 fold greater than that
16 of uninduced.

17 Sp. activity of #7 induced was @ 2-3 fold
18 higher."

19 (CX 2009 at 45.)

20 e. Chatterjee has not directed our attention to any
21 testimony explaining the relation of Chatterjee's
22 characterizations of the specific activity of
23 samples #4 and #7 to the data recorded in Hughes'
24 notebook #3048.

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1 f. In particular, we have not been directed to any
2 explanation of the 4-fold greater specific activity of
3 sample #4.

4 g. We also find in notebook #3128 at page 45 a
5 report of a test with "AccI", and the comments, "AccI
6 confirms that the clones are correct," and "I need to
7 wait for a thermostable DNA polymerase for the same or
8 similar mutation." (*Id.*)

9 h. Dr. Chatterjee testifies that he "performed a
10 restriction endonuclease assay of pSport T5 and
11 identified that the clones were mutated and in the
12 correct orientation. These experiments are recorded
13 on page 45 of notebook 3128." (CX 2043
14 at pdf15⁴, ¶ 47.)

15 i. We do not find a further explanation of the
16 experiments reported at notebook #3128 at 45 (CX 2009)
17 in Chatterjee's declaration (CX 2043).

18 j. In particular, Chatterjee has not directed our
19 attention to testimony explaining the "AccI" test or
20 the significance of Dr. Chatterjee's statement that he

⁴ The pages are not numbered in the hard copy.

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1 needed "to wait for a thermostable DNA polymerase for
2 the same or similar mutation."

3 Second embodiment (Taq F667Y)

4 39. Chatterjee argues that it has demonstrated a second
5 actual reduction to practice no later than 29 July 1994,
6 when Dr. Chatterjee received an oligonucleotide,
7 synthesized for him by the LTI synthesis facility, having
8 the stated purpose of making an F667Y mutation in Taq DNA
9 polymerase. (Paper 65 at 14.)

10 40. According to Chatterjee, after Dr. Chatterjee received
11 the oligonucleotide, he performed an oligonucleotide-
12 directed mutagenesis on the Taq polymerase gene and
13 obtained a clone incorporating the mutant sequence.
14 (Paper 65 at 14.)

15 41. Chatterjee argues that the identity of the clone was
16 confirmed by demonstration of an additional AseI
17 restriction site derived from the oligonucleotide.
18 (Paper 65 at 14.)

19 42. Chatterjee argues further that thermostable polymerase
20 activity was demonstrated by incorporating an
21 "NgoAIV - XbaI restriction fragment" into an "inducible
22 expression vector," which was transformed into bacteria.

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1 Expression was induced, and an assay of the resulting
2 culture showed thermostable polymerase activity. (Paper 65
3 at 15.)

4 43. Chatterjee cites Facts 837 and 838 in support of this
5 asserted actual reduction to practice. (Paper 65 at 14.)

6 44. Fact 837 cites CX 2062 (a from requesting synthesis),
7 CX 2043 at ¶¶ 90 and 91 (Chatterjee declaration), and
8 CX 2021 at 166 (Chatterjee laboratory notebook #3573).
9 (Paper 65 at 260-61, ¶ 837.)

10 45. Exhibit CX 2062 is a copy of a sheet headed "REQUEST
11 FOR SYNTHESIS OF OLIGONUCLEOTIDES," dated "7/26/94," from
12 "Deb K. Chatterjee," apparently requesting two
13 oligonucleotides, the sequences of which are specified.

14 46. Oligonucleotide #2 is labeled "#2680, (33-mer)" and
15 briefly described as "F667Y mutation of Taq." (CX 2062.)

16 47. Dr. Chatterjee, in ¶ 90 of his declaration (CX 2043 at
17 pdf24-25) describes the order he placed on 26 July 1994,
18 for oligonucleotides, focusing on Sequence 2680.

19 48. In particular, Dr. Chatterjee points out the
20 subsequence |GTA|ATT|AAT|, describing the triplet GTA as
21 the complement of the tyrosine codon TAC, and describing

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1 the sequence ATTAAT as the "AseI restriction site."

2 (CX 2043 at 25, ¶ 90.)

3 49. Dr. Chatterjee concludes:

4 Ms. Licha[a] completed the synthesis of the
5 oligonucleotide and provided it to me on or about
6 July 29, 1994, as shown on the bottom signature
7 line of this order form (Exhibit CX 2062), and I
8 recorded this information in notebook 3573,
9 page 166. A copy thereof is attached as exhibit
10 CX 2021, page 166.

11 (CX 2043 at 25, ¶ 90.)

12 50. Exhibit CX 2021, cited by Dr. Chatterjee, appears to
13 be a copy of part of LTI Notebook #3573.

14 51. LTI Notebook #3573 appears to have been issued to Mary
15 Longo on 27 January 1993. (CX 2021 at pdf3.)

16 52. Exhibit CX 2021 contains 24 pages; the first data page
17 is a copy of page 153; the last page is a copy of page 175.

18 53. Chatterjee Notebook #3573 at 166 is signed by
19 ("Recorded by") Chatterjee and dated "8/12/94"; it also
20 bears an illegible countersignature ("Witnessed &
21 Understood by me," that is dated "8/17/94". (CX 2021
22 at 166 [pdf 15].)

23 54. LTI Notebook #3573 at 166 refers to "Oligos ordered
24 Q582A & F667Y on 7/26/94." (CX 2021 at 166, l. 1.)

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1 55. LTI Notebook #3573 at 166: refers to Sequence 2680 as
2 a 33-mer, further labeled "F667Y"; gives the DNA base
3 sequence for the oligomer; and reports that it was
4 "dissolved in 990 µl TE: 1000 ng/µl (1 µg/µl)". (CX 2021
5 at 166, ll. 4-6.)

6 56. LTI Notebook #3573 at 166 appears to contain no other
7 indications of experiments conducted with Sequence 2680.

8 57. In particular, on page 166 there appears to be no
9 record of any experiment on 29 July 1994 showing that a
10 protein within the scope of the Count (i.e., containing
11 Sequence 2680, the critical tyrosine-for-phenylalanine
12 mutation, or the "NgoAIV - XbaI restriction fragment")
13 having DNA polymerase activity was obtained.

14 58. Moreover, on page 166, there appear to be no
15 indications that a restriction map was obtained on
16 29 July 1994.

17 59. Fact 838 is in almost the same words as

18 Dr. Chatterjee's testimony:

19 Therefore, on or about July 26, 1994, to July 29,
20 1994, I had a definite and permanent idea of a
21 mutant Taq DNA polymerase with polymerase
22 activity and non-discrimination properties
23 comprising a phenylalanine to tyrosine
24 substitution at position 667, including its full-
25 length sequence.

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1 (CX 2043 at 25, ¶ 91.)

2 60. Chatterjee, in its principal brief, does not direct
3 our attention to any testimony explaining how the events
4 alleged to have occurred on 29 July 1994, show that
5 Dr. Chatterjee had obtained a DNA molecule that encoded a
6 mutant protein having the required tyrosine-for-
7 phenylalanine substitution and DNA polymerase activity.

8 61. Chatterjee asserts that the declaration of Adam
9 Goldstein and of Harini Shandilya, together with
10 Dr. Chatterjee's notebooks, "as interpreted with
11 particularity" in their declarations, corroborate the
12 actual reduction to practice of the Taq F667Y mutant enzyme
13 on 29 July 1994. (Paper 65 at 15-16.)

14 62. In its principal brief, Chatterjee does not direct our
15 attention to particular statements in the declarations,
16 laboratory notebooks, or other documents that may have been
17 prepared by Goldstein or Shandilya, in support of its
18 Taq F667Y actual reduction to practice argument. (Paper 65
19 at 14-16.)

20 63. Facts 837 and 838, mentioned above as the only
21 statement of facts mentioned by Chatterjee in this portion

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1 of its argument, are silent as to corroborating statements
2 by Goldstein or Shandilya.

3 Abandon, Suppress, or Conceal

4 64. Chatterjee argues that it did not abandon, suppress,
5 or conceal its invention from either 12 September 1991, or
6 29 July 1994 (its two alleged actual reductions to
7 practice) and 8 September 1995 (its filing date and
8 constructive reduction to practice). (Paper 65 at 18-22.)

9 65. Chatterjee asserts that there was "a coordinated
10 effort by Dr. Chatterjee and other scientists under his
11 direction to develop isolated polynucleotides encoding
12 mutant DNA polymerases comprising the FY mutation recited
13 in the Chatterjee claims" (Paper 65 at 20, citing
14 Facts 99-1198.)

15 66. In Chatterjee's words, "[t]he coordinated effort
16 comprised: (a) isolation of DNA polymerase genes from a
17 variety of thermostable and nonthermostable organisms;
18 (b) introduction of mutations into certain of those
19 isolated polymerase genes; and (c) production and
20 characterization of the enzymatic activities of the mutant
21 DNA polymerases encoded by those genes." (Paper 65
22 at 20-21, citing Facts 99-1198.)

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1 67. Chatterjee urges that these activities were "directed
2 toward perfecting the invention that ultimately was the
3 subject of Party Chatterjee's involved patent application."
4 (Paper 65 at 21.)

5 68. Chatterjee does not, in its principal brief, make any
6 significant attempt to relate any of the activities said to
7 comprise its "coordinated effort" to the limitations of its
8 involved claims or to disclosures in its involved
9 specification.

10 Discussion

11 The statute governing interferences reads, in relevant
12 part:

13 A person shall be entitled to a patent unless--
14 * * * during the course of an interference
15 conducted under section 135 . . . another
16 inventor involved therein establishes, to the
17 extent permitted in section 104, that before such
18 person's invention thereof, the invention was
19 made by such other inventor and not abandoned,
20 suppressed, or concealed. . . . In determining
21 priority of invention under this subsection,
22 there shall be considered not only the respective
23 dates of conception and reduction to practice of
24 the invention, but also the reasonable diligence
25 of one who was first to conceive and last to
26 reduce to practice, from a time prior to
27 conception by the other.

28 35 U.S.C. § 102(g)(1). In the present case, Chatterjee has
29 not tried to show that it was diligent. Accordingly, we
30 need consider only whether Chatterjee has carried its

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1 burden of establishing a date of actual reduction to
2 practice prior to Tabor's accorded benefit date. "Proof of
3 actual reduction to practice requires satisfaction of a two
4 pronged test: (1) the party must have constructed an
5 embodiment that met every element of the interference count,
6 and (2) the embodiment must have operated for its intended
7 purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d
8 1696, 1698 (Fed. Cir. 2000).

9 Evidence submitted in a contested case in support of
10 motions must conform to the Federal Rules of Evidence.
11 Bd.R. 152. The requirements for testimony as to
12 specialized matters are also specified by regulation:

13 (a) Expert testimony that does not disclose the
14 underlying facts or data on which the opinion is
15 based is entitled to little or no weight.
16 Testimony on United States patent law will not be
17 admitted.

18 (b) If a party relies on a technical test or data
19 from such a test, the party must provide an
20 affidavit explaining:

21 (1) Why the test or data is being used,

22 (2) How the test was performed and the data
23 was generated,

24 (3) How the data is used to determine a
25 value,

26 (4) How the test is regarded in the relevant
27 art, and

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1 (5) Any other information necessary for the
2 Board to evaluate the test and data.
3 Bd.R. 158. Moreover, testimony or other evidence offered
4 solely by an inventor is entitled to no weight unless it is
5 corroborated. *Brown v. Barbacid*, 276 F.3d 1327, 1335, 61
6 USPQ2d 1236, 1240 (Fed. Cir. 2002) ("an inventor's
7 testimonial assertions of inventive facts require
8 corroboration by independent evidence.")

9 As a preliminary matter, we note that both of
10 Chatterjee's alleged dates of actual reduction to practice,
11 9 September 1991, and 29 July 1994, are prior to 11 August
12 1994, the date Tabor alleged in its priority statement as
13 its earliest corroborated actual reduction to practice.
14 (Paper 28 at 1.) Thus, if Chatterjee's motion were to be
15 granted, Tabor would not be entitled to a patent to its
16 involved claims. On the other hand, if Chatterjee does not
17 carry its burden, Tabor, as the senior party, is presumed
18 to be the prior inventor. Bd.R. 207(a)(1).

19 Chatterjee argues that John Hughes and Dr. Chatterjee
20 obtained an actual reduction to practice of the T5 F570Y
21 mutant on 12 September 1991 by showing that the prepared
22 molecule had polymerase activity. (Paper 65 at 13.)
23 Chatterjee cites only Facts 99 and 100 in support of its

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1 actual reduction to practice. (Paper 65 at 13.) Facts 99
2 and 100 read in their entirety as follows:

3 99. On or about September 12, 1991, John Hughes
4 performed experiments to purify and analyze and
5 analyze [sic] E. coli DNAP (JH19). This activity
6 was recorded on page[s] 89-92 of notebook 3048.
7 Exhibit CX2007, pages 89-92.

8 100. On or about September 12, 1991, Deb
9 Chatterjee performed [sic] a series of
10 experiments to test the enzymatic activity of the
11 mutated pSport T5 polymerase, indicating a 4 fold
12 higher specific activity in induced clone 4 over
13 the uninduced clone, and 2-3 fold higher specific
14 activity of induced clone 7 over the uninduced
15 clone. I also performed a restriction
16 endonuclease assay of pSport T5 and identified
17 that the clones were mutated and in the correct
18 orientation. These experiments are recorded on
19 page 45 of notebook 3128. Exhibit CX 2009,
20 page 45.

21 (Paper 65 at 51.) Notebook #3048 appears to have been
22 issued to Hughes. (CX 2007 at pdf3.) Notebook #3128
23 appears to have been issued to Dr. Chatterjee. (CX 2009
24 at pdf3.)

25 Chatterjee, in its principal brief, does not direct
26 our attention to any credible testimony that explains, on
27 the basis of the notebook disclosures, how the experiments
28 were conducted, how any values reported were determined
29 from the raw data, and why those skilled in the art would
30 consider those experiments to be a reasonable proof that
31 the polymerases worked for their intended purpose. We have

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1 reviewed notebook #3048, pages 89-92 (CX 2007, 89-92 and
2 three extra pages apparently inserted between pages 90
3 and 91 in the original notebook) and notebook #3128,
4 page 45 (CX 2009 at 45), but find they do not "speak for
5 themselves," at least to us. They are too terse to enable
6 us, non experts in this art, to make findings of fact as to
7 their meaning or importance in support of the alleged
8 actual reduction to practice on 12 September 1991.⁵ Absent
9 testimony explaining experiments in accord with Bd.R. 158,
10 and, if the opposing party sees fit to file it, cross-
11 examination testimony of the declarant, we are seldom in a
12 position to evaluate the evidence on which a party relies
13 to support its case. Under such circumstances, we are
14 constrained to accord such evidence no weight. Thus,
15 Chatterjee's failure to timely present and explain⁶ the
16 evidence on which it relies is sufficient reason to deny

⁵ We are able to determine, however, that at least the first sentence of Fact 100 is **not** true: Dr. Chatterjee did **not** conduct experiments to test the activity of "the mutated pSport T5 polymerase." CX 2009, page 45, indicates that the samples were given to "J. Hughes" for analysis. Chatterjee's inaccurate handling of its own record decreases still further our confidence in the force of its arguments.

⁶ At oral argument, Chatterjee pointed to a declaration signed by Professor Myron F. Goodman (CX 2075) as supporting its *prima facie* case. (Paper 107 at 20, l. 18ff.) As the panel noted then (*id.* at 21, l. 16, through 22, l. 7), Chatterjee's principal brief on priority was filed [on 11] July 2006, whereas Dr. Goodman did not sign his declaration until 12 October 2006. Dr. Goodman's testimony comes too late to support Chatterjee's case-in-chief, and we shall not consider it.

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1 Chatterjee Motion 1 as to proof of an actual reduction to
2 practice on 12 September 1991.⁷

3 A party's brief must not only refer specifically to
4 evidence in support of its position—it must (when, as here,
5 it is necessary) explain the evidence and explain why that
6 evidence supports the relief it has requested. In other
7 words, a party must argue its case. The Board will not act
8 as an advocate for a party that has failed to argue its
9 case.

10 In our experience, laboratory notebooks recording
11 specialized experiments rarely "speak for themselves" to
12 non-specialist readers. These notebooks are no exception.
13 Outside of some of Hughes' entries, there are few, if any,
14 indications to the non-expert reader precisely what were
15 the goals of the experiments. Similarly, there are few, if
16 any, indications of whether those goals were achieved. Not
17 surprisingly, because this is not normally the purpose of a
18 laboratory notebook, there appear to be no explanations of
19 how the experiments worked, or how the results were
20 obtained and interpreted. Chatterjee's burden to explain,
21 with the assistance of a knowledgeable witness, its

⁷ Moreover, Chatterjee, in its principal brief, does not direct our attention to any credible testimony or evidence corroborating Dr. Chatterjee's notebook, i.e., his alleged recognition, on 12 September 1991, of the actual reduction to practice.

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1 evidence, is dictated by common principles of fairness.
2 Chatterjee's mode of argument, if permitted, would unfairly
3 burden the other party by forcing them to hypothecate the
4 strongest argument Chatterjee could make from Chatterjee's
5 own record, and to then set about evaluating and developing
6 evidence to support an argument opposing the hypothetical
7 substantive motion. Similarly, while the Board is fairly
8 charged with understanding and evaluating a well-posed and
9 well-supported argument, it is under no obligation to
10 shoulder the burden of divining what arguments a movant
11 intended to make based on the evidence presented.
12 Administrative Patent Judges are adjudicators, not
13 advocates.

14 Because Chatterjee does not argue diligence, we need
15 not and do not consider Chatterjee's case for conception on
16 14 June 1991.

17 In summary, we determine that Chatterjee has failed to
18 prove an actual reduction to practice of an embodiment
19 within the scope of the Count on 12 September 1991.

20 Chatterjee argues that it has demonstrated a second
21 actual reduction to practice no later than 29 July 1994,
22 when Dr. Chatterjee received an oligonucleotide synthesized

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1 for him having the stated purpose of making an F667Y
2 mutation in Taq DNA polymerase. (Paper 65 at 14.)
3 According to Chatterjee, after Dr. Chatterjee received the
4 oligonucleotide, he performed an oligonucleotide directed
5 mutagenesis on the Taq polymerase gene and obtained a clone
6 incorporating the mutant sequence. (Paper 65 at 14.)
7 Chatterjee argues that the identity of the clone was
8 confirmed by demonstration of an additional AseI
9 restriction site derived from the oligonucleotide.
10 (Paper 65 at 14.) Chatterjee argues further that
11 thermostable polymerase activity was demonstrated by
12 incorporating an "NgoAIV - XbaI restriction fragment into
13 an "inducible expression vector," which was transformed
14 into bacteria. According to Chatterjee, expression was
15 induced, and an assay of the resulting culture showed
16 thermostable polymerase activity. (Paper 65 at 15.)

17 The only evidence that Chatterjee cites in its
18 principal brief in support of an actual reduction to
19 practice on 29 July 1994 are Facts 837 and 838. (Paper 65
20 at 14.) Facts 837 and 838 cite a request for synthesis of
21 two oligonucleotides (CX 2062), Dr. Chatterjee declaration
22 (CX 2043, ¶¶ 90 and 91), and LTI notebook #3573 (CX 2021
23 at 166). (Paper 65 at 260-61, ¶¶ 837-38.) Our review of

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1 exhibit CX 2062 persuades us that it is fairly
2 characterized as a request for synthesis of an
3 oligonucleotide. However, our review of Dr. Chatterjee's
4 declaration (CX 2043) and notebook (CX 2021 at 166) does
5 not permit us to conclude that he performed, **on 29 July**
6 **1994**, any of the experiments Chatterjee asserts showed the
7 invention worked for its intended purpose. We find no
8 indication of a demonstration on that date of an AseI
9 restriction site in the purported DNA polymerase molecule
10 or that the purported DNA polymerase molecule exhibited
11 thermostable polymerase activity. Indeed, as near as we
12 can tell from notebook page 166, and as Chatterjee
13 confirmed at oral argument⁸, all Dr. Chatterjee had on
14 29 July 1994 was the oligonucleotide he had ordered.
15 Dr. Chatterjee did not have the complete DNA molecule
16 encoding a DNA polymerase as recited in the Count, not to
17 mention the protein coded for by that DNA, that could be
18 tested for any of its properties. At oral argument,
19 Chatterjee urged that proof of an actual reduction to
20 practice merely requires proof of "possession" of the
21 invention (Paper 107 at 14, ll. 14-19), apparently as that

⁸ Paper 107 at 11, l. 22, through 12, l. 3:

Q: What's the date of the actual reduction to practice?
Mr. McCabe: July 29 when the oligo was made.

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1 term is used in discussions of written description. This
2 argument is utterly without merit. Chatterjee appears to
3 have conflated the requirement for conception with the
4 requirement for actual reduction to practice. The term
5 "actual" in "actual reduction to practice" means exactly
6 what it says. Thus, we reject Chatterjee's proof of an
7 actual reduction to practice on 29 July 1994.

8 Because Chatterjee has failed to establish a *prima*
9 *facie* case for an actual reduction to practice, we need not
10 consider Chatterjee's position that Goldstein and Shandilya
11 provided adequate corroboration. Similarly, we need not
12 consider Chatterjee's arguments that it did not abandon,
13 suppress, or conceal its invention.

14 Chatterjee's motion that it proved an actual reduction
15 to practice of an embodiment within the scope of the Count
16 on 29 July 1994, fails for lack of any credible supporting
17 evidence.

18 Chatterjee has failed to show, by a preponderance of
19 the evidence, that it actually reduced to practice an
20 embodiment of the Count prior to Tabor's accorded benefit
21 date. Chatterjee has not alleged, in its principal brief,
22 diligence from a date prior to Tabor's earliest conception

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1 through a reduction to practice, whether actual or
2 constructive. Thus, there is no basis on which Chatterjee
3 can overcome Tabor's status as the senior party in this
4 interference.

5 Accordingly, Tabor's motions are moot. Because we
6 need not and do not reach Tabor's motions, Chatterjee's
7 motion 2, to exclude certain evidence, is also moot.

8 Judgment adverse to Chatterjee is entered in Paper 109,
9 mailed on the same date as this Decision.

10 IV. Order

11 For the reasons given *supra*, it is

12 ORDERED that Chatterjee Motion 2 for priority is
13 DENIED.

14 FURTHER ORDERED that Chatterjee Motion 3 is
15 DISMISSED.

16 FURTHER ORDERED that Tabor Motion 2 is DISMISSED.

17 FURTHER ORDERED that Tabor Motion 3 is DISMISSED.

18 FURTHER ORDERED that Tabor Motion 4 is DISMISSED.

19 FURTHER ORDERED that a copy of the DECISION shall
20 be entered into the records of Application 09/558,421 and
21 U.S. Patent 5,614,365.

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1 FURTHER ORDERED that in the event of a settlement,
2 the attentions of the parties are drawn to 35 U.S.C.
3 § 135(c) and Bd.R. 205.
4

/Romulo H. Delmendo/)

ROMULO H. DELMENDO)

Administrative Patent Judge)

)

)

/Sally Gardner Lane/) BOARD OF PATENT

SALLY GARDNER LANE) APPEALS AND

Administrative Patent Judge) INTERFERENCES

)

)

/Mark Nagumo/)

MARK NAGUMO)

Administrative Patent Judge)

Interference 105,292
Chatterjee v. Tabor

Paper 108

cc (via Overnight mail):

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JS 44 (Rev. 11/04)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

Invitrogen Corporation, a Delaware corporation

(b) County of Residence of First Listed Plaintiff _____
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Michael R. Gottfried, Duane Morris LLP
470 Atlantic Ave, Suite 500, Boston, MA 02210, 857.488.4200

DEFENDANTS

President and Fellows of Harvard College, a Massachusetts corporation

County of Residence of First Listed Defendant _____
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE
LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition		

V. ORIGIN

- (Place an "X" in One Box Only)
- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from another district (specify)
- ☐ 6 Multidistrict Litigation
- ☐ 7 Appeal to District Judge from Magistrate Judgment

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
35 U.S.C. 146

VI. CAUSE OF ACTION

Brief description of cause:

Civil action to remedy decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No**VIII. RELATED CASE(S) IF ANY**

(See instructions):

JUDGE

DOCKET NUMBER

DATE

05/15/2007

SIGNATURE OF ATTORNEY OF RECORD

/s/ Michael R. Gottfried

FOR OFFICE USE ONLY

RECEIPT # _____ AMOUNT _____ APPLYING IFP _____ JUDGE _____ MAG. JUDGE _____

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

1. Title of case (name of first party on each side only) Invitrogen Corporation v. President and Fellows of Harvard College
2. Category in which the case belongs based upon the numbered nature of suit code listed on the civil cover sheet. (See local rule 40.1(a)(1)).
- ☐ I. 160, 410, 470, 535, R.23, REGARDLESS OF NATURE OF SUIT.
- ☒ II. 195, 196, 368, 400, 440, 441-446, 540, 550, 555, 625, 710, 720, 730, *Also complete AO 120 or AO 121 for patent, trademark or copyright cases
740, 790, 791, 820*, 830*, 840*, 850, 890, 892-894, 895, 950.
- ☐ III. 110, 120, 130, 140, 151, 190, 210, 230, 240, 245, 290, 310, 315, 320, 330, 340, 345, 350, 355, 360, 362, 365, 370, 371, 380, 385, 450, 891.
- ☐ IV. 220, 422, 423, 430, 460, 480, 490, 510, 530, 610, 620, 630, 640, 650, 660, 690, 810, 861-865, 870, 871, 875, 900.
- ☐ V. 150, 152, 153.
3. Title and number, if any, of related cases. (See local rule 40.1(g)). If more than one prior related case has been filed in this district please indicate the title and number of the first filed case in this court.
4. Has a prior action between the same parties and based on the same claim ever been filed in this court?
YES ☐ NO ☒
5. Does the complaint in this case question the constitutionality of an act of congress affecting the public interest? (See 28 USC §2403)
YES ☐ NO ☒
If so, is the U.S.A. or an officer, agent or employee of the U.S. a party?
YES ☐ NO ☐
6. Is this case required to be heard and determined by a district court of three judges pursuant to title 28 USC §2284?
YES ☐ NO ☒
7. Do all of the parties in this action, excluding governmental agencies of the united states and the Commonwealth of Massachusetts ("governmental agencies"), residing in Massachusetts reside in the same division? - (See Local Rule 40.1(d)).
YES ☐ NO ☒
- A. If yes, in which division do all of the non-governmental parties reside?
Eastern Division ☐ Central Division ☐ Western Division ☐
- B. If no, in which division do the majority of the plaintiffs or the only parties, excluding governmental agencies, residing in Massachusetts reside?
Eastern Division ☒ Central Division ☐ Western Division ☐
8. If filing a Notice of Removal - are there any motions pending in the state court requiring the attention of this Court? (If yes, submit a separate sheet identifying the motions)
YES ☐ NO ☐

(PLEASE TYPE OR PRINT)

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